

REMARKS

Favorable reconsideration and allowance of the present application is respectfully requested.

Claims 1-4, 7-17, 19-22, 24-27, 29, and 44-45 are currently pending in the present application, including independent claims 1 and 22. Independent claim 1, for instance, is directed to an absorbent paper product for drying and conditioning the skin of a user. The paper product includes a paper web that is applied with a water-soluble lotion such that the add-on level of the lotion is between about 1% to about 10% by weight of the paper product. The lotion comprises water in an amount between about 10% to about 90% by weight of the lotion composition, a water-soluble skin conditioning component in an amount between about 10% to about 75% by weight of the lotion composition, and a viscosity-increasing component in an amount between about 2% to about 10% by weight of the lotion composition.

In the Office Action, original claims 1-4, 11, 13, 14-17, 19-22, 26-27, and 29 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over certain claims of copending Application No. 09/717,939 entitled "Paper Products with Oil-in-Water Emulsions." Without commenting on the propriety of this rejection, Applicants agree to submit a terminal disclaimer at such time that the claims of the present application are deemed to otherwise be allowable.

Further, original claims 1-4, 7-17, 19-21, and 44 were also rejected under 35 U.S.C. §112, second paragraph, as being indefinite. For instance, the phrase "said

paper product being selected from the group consisting of towels, wipes, and napkins" in claim 1 was objected to as being vague and indefinite. Without commenting on the propriety of this rejection, claim 1 has nonetheless been amended in accordance with the Examiner's suggestion.

In addition, claim 13 calls for a surfactant that inhibits the lotion composition from "separating into more than one liquid phase." Claim 13 was objected to as not defining any chemical or physical characteristic. Specifically, it was stated that the "specification does not define such surfactants and one of ordinary skill in the art would not be apprised of them." However, as noted in previous responses, surfactants that inhibit phase separation are well known as "coupling agents." One of ordinary skill in the art is certainly apprised of surfactants that function as coupling agents. For instance, at least one of the references previously cited by the Examiner also refers to a "coupling agent". (See e.g., U.S. Patent No. 5,661,119 to Hersh, et al., Col 2, lines 59-67). In addition, it is noted that the specification does in fact provide sufficient information for one of ordinary skill in the art to ascertain the meaning of this claim. In particular, the specification states that the liquid coupling agents "couple" the ingredients the ingredients of the composition together to ensure that the lotion composition "does not separate into more than one liquid phase." Multiple examples of such surfactants are provided at pages 9-11 of the specification. Thus, for at least these reasons, one of ordinary skill in the art would be apprised of the meaning the phrase set forth in claim 13.

Besides the above-mentioned rejections, independent claims 1 and 22 were rejected under 35 U.S.C. §103 as being unpatentable over WO 00/64408. However, WO 00/64408 published on November 2, 2000, while the present application was filed on November 21, 2000. Thus, WO 00/64408 is not effective as prior art under 35 U.S.C. §102(b). In addition, WO 00/64408 has an international filing date prior to November 29, 2000, and thus, is examined under 35 U.S.C. §102(e) prior to the American Inventors Protection Act (AIPA) of 1999. According to the prior version of §102(e), the reference must be a U.S. patent or Statutory Invention Registration (SIR) to be eligible for use as prior art under this section. (See e.g., MPEP, §2136.03). Thus, it is believed that WO 00/64408 is not available as prior art to the present application.

*but 102(a)
will apply*

In the Office Action, independent claims 1 and 22 were also rejected over WO 98/03147. WO 98/03147 is directed to fibrous sheet materials applied with an oat extract solution. The oat extract solution includes an effective amount of oat extract and a solubilizing agent. Glycerin is said to be an effective solubilizer of the oat extract. The oat extract solution may also include emollients, moisturizers, surfactants, preservatives, etc. (pg. 4). However, contrary to independent claims 1 and 22, WO 98/03147 does not disclose the use of an alkoxylated alcohol surfactant (e.g., talloweth-60-myristyl glycol). In fact, the specific surfactants mentioned (e.g., coco phosphatidyl PG-dimonium chloride, pg. 8) are said to be used for improving skin cleansing properties. Thus, for at least this reason, Applicants respectfully submits that independent claims 1 and 22 patentably define over WO 98/03147.

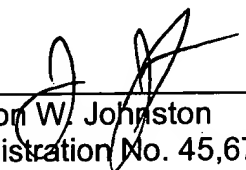
In addition, the above-cited references were also cited in various combinations to reject dependent claims 2-4, 7-17, 19-21, 24-27, 29, and 44-45. Applicants respectfully submit, however, that at least for the reasons indicated above relating to corresponding independent claims 1 and 22, claims 2-4, 7-17, 19-21, 24-27, 29, and 44-45 patentably define over the references cited. However, Applicants also note that the patentability of dependent claims 2-4, 7-17, 19-21, 24-27, 29, and 44-45 does not necessarily hinge on the patentability of independent claims 1 and 22. In particular, some or all of these claims may possess features that are independently patentable, regardless of the patentability of claims 1 and 22.

Thus, Applicants respectfully submit that the present claims patentably define over all of the prior art of record and satisfy all of the requirements of 35 U.S.C. §112. It is believed that the present application is in complete condition for allowance and favorable action, therefore, is respectfully requested. Examiner Wells is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this response.

Please charge any additional fees required by this Amendment to Deposit Account No. 04-1403.

Respectfully requested,

DORITY & MANNING, P.A.



Jason W. Johnston
Registration No. 45,675

DORITY & MANNING, P.A.
P. O. Box 1449
Greenville, SC 29602-1449
Phone: (864) 271-1592
Facsimile: (864) 233-7342

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